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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323
24628	7590	10/17/2007	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	
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			10/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/777,098

**Applicant(s)**

BERNSTEIN, ROBERT

**Examiner**

Jeffrey D. Carlson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to the papers filed 8/6/2007.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 17 recites "information from a plurality of independent vendors" – it is unclear how a source and/or a delivery mechanism of this information can limit the structure of the database merely containing the information in this system claim. Is this a step of providing information from the vendors to the database?? A database physically storing information is the same apparatus regardless of where the information came from or who provided the information for storage.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6, 8-14, 16-20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac (US2003/0018613) in view of Taricani, Jr. (US6347304) or alternatively over Taricani, Jr. in view of Oytac. Oytac is a published application which enjoys the earlier benefit of and incorporates by reference provisional application number 60/221774 (filed 7/31/00). This Office Action shall refer to the disclosure of 60/221774 by page number rather than the 2003/0018613 document.**

Regarding claims 1, 9, 17, Oytac teaches information providers (banks, credit card processors, etc.) that compile detailed user profiles concerning the user's purchasing histories. This is taken to provide a third party database. Information users (vendors) define desired profiles for users who are to receive targeted promotional materials. Customers who match the defined profiles are selected as the recipients of the defined promotional materials [pg 1 of 60/221774]. Oytac teaches that an interface is provided for a vendor to define the desired profile characteristics and the promotional materials to be delivered [pg 2, fig 1 of 60/221774]. The system of Oytac performs a matching of stored profiles and defined desired profiles and is taken to meet the comparator/searching limitations. Oytac's system then can automatically deliver the promotional materials. Oytac does not however explicitly state that the database system of consumer purchase information is one which also calculates taxes due on such purchases. Oytac describes the added value present in a system which stores digital "transaction data regarding consumer purchases". Oytac states that banks and credit card processors are two such system examples, however Oytac also states that further examples are contemplated (banks, credit card processors, "etc") [page 1 line 1].

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Taricani, Jr. teaches a tax system wherein consumer transaction data is stored in a database that includes purchaser identity, dates, amounts, purchase item categories, etc. [col 7 lines 23-30]. The system of Taricani, Jr. calculates a tax due based on the consumer's purchasing history [col 7 lines 1-3]. Clearly one of ordinary skill would recognize that such a database of digital consumer purchasing data also has value for marketing purposes. It would have been obvious to have provided the features of Oytac with the system of Taricani, Jr. so that additional revenue could be generated from the valuable consumer data. Likewise, it would have been obvious that the marketing system of Oytac could be implemented with an entity that provided such a tax-related consumer purchasing database.

Regarding claims 2-4, 10-12, 18, 19, Oytac teaches that a POS system can provide trigger-driven promotions printed on a receipt [pg 4]. Oytac teaches that the promotions can include coupons [pg 2].

Regarding claims 5, 13, Oytac teaches a promotional delivery channel using email [pg 4].

Regarding claims 6, 14, 20, the broad limitation that the promotional materials include "indicia of authenticity" without any corresponding steps or feature to verify the authenticity of such indicia can be met by any indicia printed on the promotion of Oytac. The printed materials of Oytac are taken to inherently include at least some "indicia".

Regarding claims 8, 16, 22, Oytac teaches an example where promotions are based upon types of purchases [pg 5]. Oytac also teaches the use of product

categories [pg 22]. Further, Taricani, Jr. teaches that the purchasing data can also include item categorization [col 7 line 28].

**Claims 7, 15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac in view of Taricani, Jr. and Katz (US20020077901) or alternatively over Taricani, Jr. in view of Oytac and Katz.**

Page 10 of Katz's 60/256324 has been included to demonstrate support for the important feature to 12/19/2000.

Regarding claims 7, 15, 21, Oytac teaches targeting to users based upon location [pg 5], but not necessarily based upon purchase location. Katz teaches custom promotions offered to users that includes various user profile parameters including locations where purchases were made [¶ 40]. It would have been obvious to one of ordinary skill at the time of the invention to have targeted the consumers of Oytac/Taricani with such a purchase location parameter.

### ***Response to Arguments***

Applicant argues that Taricani, Jr. acts on the behalf of the revenue agency and is therefore limited by agency law and "US privacy law", yet applicant provides no specific legal citations. Nonetheless, the examiner is treating the claims and applying prior art with respect to technological achievements/aspects rather than any ethical, political or legal hurdles that may impede a proper obvious combination. Further, and as applicant is clearly aware, it is routine for entities to first get opt-in acceptance from

users before their private or consumer information may be used for marketing/advertising purposes. Such would be an obvious aspect for one of ordinary skill and for the proposed combination.

Examiner believes that one of ordinary skill would find it obvious to try to target the consumer profiles of Taricani, Jr. given the teachings of Oytac and in the alternative to provide the tax services of Taricani, Jr. with that of Oytac. The cited article "IRS may let tax preparers sell customer's information" provides evidence that the IRS allows tax preparers to target consumers according to their private information. In fact, the IRS is keen to expand that use of consumer information to enable any third party to use it for marketing purposes. One of ordinary skill would find it obvious to extract marketing value from the tax database of Taricani, Jr. by way of targeting advertising/marketing in the interest of generating revenue. Whether this is ethical/legal or not does not prevent one of ordinary skill from considering such acts or if needed, to change policies to permit it. If indeed penalties are in place for using such private information, those penalties inherently represent consideration of doing such an act, rendering the act obvious.

Applicant argues that Taricani, Jr. is not a database of past purchases, yet admits Taricani, Jr. provides a "database of transactions". Whether the taxes have been paid or not is outside the current claim scope. "Why" the claimed database exists does not prevent the combination from reading on the current claims.

Applicant's argument that the Taricani, Jr. database is one having possible criminal evidence is an argument that does not appear pertinent.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc